

Application No.: 09/662,224
Amendment dated: April 11, 2005
Reply to Office Action dated: December 10, 2004

REMARKS/ARGUMENTS

Claims 94-108 are pending in the application. Claims 1-33 are cancelled. Claims 34-93, and 109-168 are withdrawn. Claim 94 has been amended. Claims 169-199 have been added. No new matter has been added.

Claims 94, 102, and 106-107 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,320,102 to Paul et al (Hereinafter "Paul"). Claim 96 is rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 5,291,401 to Robinson et al (Hereinafter "Robinson"). Claims 103-105 and 108 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 5,206,023 to Hunziker et al (Hereinafter "Hunziker"). Claims 95 and 97-101 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent base form.

Election of Species

Claims 34-93, and 109-168 were withdrawn as a result of the election of species of February 4, 2004. Claims 94-108 read on the elected species. Claim 199 has been added as a linking claim, readable on the various species on which claims 34-168 read. If claim 199 is found to be allowable, claims 34-168 should be found allowable as well.

Rejections under 35 U.S.C. §102

Claims 94, 102, and 106-107 are rejected under 35 U.S.C. §102(b) as being anticipated by

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Paul. Paul discloses diagnosing Proteoglycan deficiency in articular cartilage based on quantified signal intensities of pixels of a magnetic resonance image (MRI) extending across a depth of the articular cartilage (*See Abstract*).

The Applicants respectfully traverse these rejections, in part, because Paul does not disclose electronically evaluating said image to obtain information about the three dimensional geometry of the joint, as called for in claim 94 as amended, nor does the Office Action suggest that it does.

Since at least this feature of claim 94 is missing from Paul, the Paul reference fails to anticipate claim 94 under 35 U.S.C. §102(b). Applicant further respectfully submits that claims 102 and 106-107 are allowable as depending from the allowable base claim 94.

Rejections under 35 U.S.C. §103

Claim 96 is rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of Robinson. Robinson discloses a teleradiology system for sending the raw data from a complete patient study to a remote location for a radiologist to make a final diagnosis (*See Abstract*).

The Applicants respectfully traverse these rejections, in part, because neither Paul, Robinson, nor any combination thereof teach or suggest electronically evaluating said image to obtain information about the three dimensional geometry of the joint, as called for in claim 94 as amended, nor does the Office Action suggest that it does.

Since at least this feature of claim 94 is missing from Paul and Robinson, the Paul and

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Robinson references fail to render claim 94 obvious under 35 U.S.C. §103(a). Applicant further respectfully submits that claim 96 is allowable as depending from the allowable base claim 94.

Claims 103-105 and 108 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of Hunziker. Hunziker discloses methods and compositions for the treatment and repair of defects or lesions in the cartilage of humans and other animals (*See Abstract*).

The Applicants respectfully traverse these rejections, in part, because neither Paul, Hunziker, nor any combination thereof teach or suggest electronically evaluating said image to obtain information about the three dimensional geometry of the joint, as called for in claim 94 as amended, nor does the Office Action suggest that it does.

Since at least this feature of claim 94 is missing from Paul and Hunziker, the Paul and Hunziker references fail to render claim 94 obvious under 35 U.S.C. §103(a). Applicant further respectfully submits that claims 103-105 and 108 is allowable as depending from the allowable base claim 94.

New Claims

Claims 169-199 have been added. No new matter has been added.

Claims 169 is similar to claim 98 prior to amendment, with the exception that the element “selecting a therapy based on said information” has been replaced by “determining a shape for articular repair based on said geometrical information.” The new limitation is not present in Paul, Robinson, Hunziker, or any combination thereof. Therefore independent claim 169 and

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dependent claims 170-183 should be allowed..

Claims 184 is similar to claim 98 prior to amendment, with the exception that the word "selecting" has been replaced by "designing." This change represents a different treatment approach not present in Paul, Robinson, Hunziker, or any combination thereof. Therefore independent claim 184 and dependent claims 185-198 should be allowed.

It is believed that this Amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

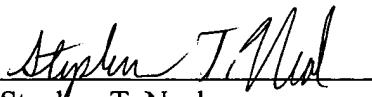
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to Deposit Account No. **11-0600**.

Respectfully submitted,

KENYON & KENYON

Dated: April 11, 2005

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